

***Remarks***

The foregoing amendments to the claims are believed to place the claims into condition for immediate allowance or into better condition for consideration on appeal. Moreover, the amendments merely clarify Applicants' invention and do not raise new issues for consideration by the Examiner. Reconsideration of this Application is respectfully requested.

Applicants note that on August 17, 2001 a First Supplemental Information Disclosure Statement ("IDS") was filed in the captioned application. Applicants respectfully request that the Examiner return initialled and signed PTO-1449 forms indicating the Examiner's consideration of the documents accompanying the First Supplemental IDS.

Claims 4-6, 9-11, 24, 26 and 35-36 are now pending in the application, with claims 4, 6 and 24 being the independent claims. Claims 4-6, 9-11, 24 and 26 have been amended, and claims 35 and 36 are newly presented. Claims 1-3, 7-8, 12-23, 25 and 27-34 have been cancelled without prejudice or disclaimer in order to put the application in condition for allowance. Applicants reserve the right to prosecute such claims or the subject matter thereof in further applications. New claims 35 and 36 are identical to claims 10 and 11, respectively, except for their dependencies to claim 24 as opposed to allowable claim 4. The instant amendments are believed to introduce no new matter since the amendments are of an editorial nature. Thus, Applicants respectfully submit that the amendments to the claims simplify and clarify the subject matter found allowable or allowed by the Examiner (claims 4-6, 9 and 26). Claim 10 has been amended to be dependent on allowable claim 4.

Support for the amendment to claim 4 is found throughout the specification. For example, the specification states:

One of these RNAs corresponds to a PCA3 RNA molecule having an additional sequence of 228 bp (shown in **SEQ ID NO:1**[]) inserted between exons 3 and 4a . . . the RNA [with additional sequence (SEQ ID NO:1)] is associated with a non-malignant prostatic state.

Specification at page 5, lines 21-26 (emphasis added). Claim 4 is directed to "[a]n isolated nucleic acid molecule comprising the nucleotide sequence of SEQ ID NO:1,

wherein said isolated nucleic acid molecule is differentially expressed in a non-malignant prostate."

Adequate written description for a particular claim limitation requires that one of ordinary skill be informed that the applicant was in possession of the claimed invention as a whole at the time the application was filed. MPEP § 2163. The written description requirement *does not* require that the language of the claims and the language of the specification be exactly the same. MPEP § 2163.

It is respectfully submitted that the written description in the specification quoted above fully supports the amended claim language. The specification states that SEQ ID NO:1 is associated with a non-malignant prostatic state, i.e., SEQ ID NO:1 is differentially expressed in a non-malignant prostate.

Support for claim 24, and hence new claims 35-36 dependent thereon, is found, for example, on page 29, lines 19-23; page 30, lines 9-13; page 34, lines 1-12; page 35, lines 7-14; page 39, lines 3-7; and, page 43, lines 17-23.

Applicants thank the Examiner for the withdrawal of: (1) the objection to the disclosure for an embedded hyperlink; (2) the rejection of claims 3 and 25-30 under 35 U.S.C. § 112, second paragraph; and, (3) the rejections under 35 U.S.C. § 102(b). Applicants also thank the Examiner for the allowance of claims 6, 9 and 26 and for considering the subject matter of claims 4 and 5 as allowable if rewritten in independent form. Accordingly, claim 4 has been rewritten in independent form including all the limitations of the base claim and intervening claims. Claim 5 has been rewritten to be dependent on claim 4 rather than in independent form.

Applicants believe that the Examiner intended to allow claim 24 since it was not rejected under any grounds in the OA dated October 27, 2004 and was listed in the "Disposition of Claims" section in the first page of the OA as being objected to, rather than rejected. Applicants request clarification from the Office regarding the status of this claim.

***Rejections Under 35 U.S.C. § 112, first paragraph***

The rejection of claims 1-3, 10-12, 25 and 27-34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement has been rendered moot by cancellation of rejected claims 1-3, 12, 25 and 27-34. Applicants submit that while rejected claims 10-11 have been retained, their amended

dependency to allowable claim 4 overcomes the rejection under 35 U.S.C. § 112, first paragraph.

Applicants reiterate that the foregoing amendments have been made solely to expedite prosecution and should not be taken as acquiescence to the Office's rejections.

***Rejections Under 35 U.S.C. § 112, second paragraph***

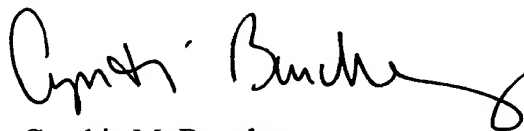
The rejection of claim 1 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for lack of antecedent basis for "said longer isolated nucleic acids" has been rendered moot by cancellation of this claim.

***Conclusion***

Prompt and favourable consideration of this Amendment is respectfully requested. Applicants believe the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Cynthia M. Bouchez  
Attorney for Applicants  
Registration No. 47,438

Date: September 27, 2005  
1100 New York Avenue, N.W.  
Washington, D.C. 20005-3934  
(202) 371-2600

447436\_1.DOC